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09/896,375	06/29/2001	Richard J.H. Wilson	STEINER 00.01	9550

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EXAMINER

SHERRER, CURTIS EDWARD

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 12/23/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/896,375
Filing Date: June 29, 2001
Appellant(s): WILSON ET AL.

Norman P. Soloway
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09/07/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences that will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellants' statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellants' statement of the issues in the brief is correct. The issue based on 35 USC § 112 has been withdrawn.

(7) *Grouping of Claims*

The rejection of claims 17, 18, and 20-22 stand or fall together because appellants' brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,583,262

Maye *et al.*

12-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 17, 18 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maye *et al.* (U.S. Pat. No. 5,583,262) ("Maye").

Maye teaches the production of beers using rho-isoalpha acids. The acids can be comprised of potassium, sodium, calcium or magnesium. (See claim 14 of patent). Examples 5-8 teach the specific examples of heating aqueous alkaline solutions with stirring. The use of heat and agitation is well known in the chemical reaction arts to increase reaction rates. Also see col. 5, lines 16-31, where Maye states

The hop bittering compounds are either isolated via a series of aqueous alkaline extractions from hop extract or produced by thermal isomerization and or thermal isomerization-reduction of the alpha acids or beta acids. The resulting hop acids such as alpha acids, beta acids, isoalpha acids, reduced-isoalpha acids are then mixed with water and basified with potassium hydroxide and or potassium carbonate or the like to a pH above 5. The product is salt precipitated by adding a salt such as potassium carbonate, the salted oil is isolated and the residual water is removed by one of the previously mentioned drying conditions and a solid material is obtained. . . . It is to understand that these examples are not meant to limit the present invention, the scope of which is determined by the appended claims.

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The resulting mixture has a pH of above 5, i.e., “substantially neutral or slightly alkaline.” *Id.* It is noted that the scope of the quoted phrase is in doubt and has yet to be clarified and therefore, said phrase is broadly interpreted. The temperature of the final mixture would inherently be room temperature, as it is broadly interpreted.

The claims require first heating a concentrated solution of the claimed acids and then adding the concentrated aqueous alkali metal hydroxide solution to the heated acids. It would have been obvious to those of ordinary skill in the art to heat the acids before adding the alkali because selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results. *In re Burhans*, 154 F.2d 690, 69 USPQ 30 (CCPA 1946). Selection of any order of mixing ingredients is *prima facie* obvious. *In re Gibson*, 5 USPQ 230 (CCPA 1930).

(11) Response to Argument

With regard to the obviousness rejection Appellants argue that the claims are not obvious because the Maye patent does not teach reacting iso alpha acid with an alkaline metal hydroxide. As noted above in the formal rejection, Maye indeed teaches the use of potassium hydroxide, the preferred alkaline metal hydroxide.

Appellants also argue that if the steps of heating the concentrated solution of reduced iso alpha acids and then adding the aqueous alkali metal hydroxide solution is reversed, i.e., adding the two solutions together and then heating, the resulting product is different. No evidence has been provided showing that this is, in fact, the case. The table, found on page 11 of the instant Brief, compares using an alkaline metal salt to the use of an aqueous hydroxide solution and

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therefore, the comparison is similar to the comparison of apples to oranges.

It is noted that the instant claims are broad, in that the preamble uses the phrase "comprising" (which is open ended), and do not exclude other steps that may be disclosed by the cited patent. Specifically, the fact that Maye further treats the basified mixture does not diminish its teachings with respect to the rejected claims.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Curtis E. Sherrer, Esq.
Primary Examiner
Art Unit 1761

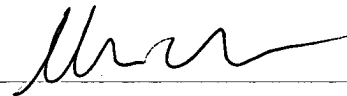
December 16, 2004

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